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Examiner: John C. Hong
Group Art Unit: 3726

REMARKS

Claims 1-36 were in the application as filed. The Examiner has required restriction between alleged invention I (claims 1-18, 23-36) and alleged invention II (claims 19-22), and Applicant has provisionally elected alleged invention I (claims 1-18, 23-36) with traverse.

Restriction Requirement

The Examiner has required restriction between alleged invention I (claims 1-18, 23-36), which relate to a reciprocating air hammer for removing a friction-fit or press-fit component from a seat, and alleged invention II (claims 19-22), which relate to a method for using a reciprocating air hammer to remove a friction-fit or press-fit component from a seat. The restriction requirement is respectfully traversed as being improper.

Alleged inventions I and II have the unifying concept of a reciprocating air hammer for removing a friction-fit or press-fit component from a seat, and are not independent and distinct. Restriction may be required if two or more "independent and distinct" inventions are claimed in one application. 35 U.S.C. §121. According to the Manual of Patent Examination Procedure §802.01, "independent" means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect. "Distinct" means that two or more subjects as disclosed are related, for example, as a combination and a part or subcombination thereof, a process and an apparatus for its practice, a process and a product made, etc., but are capable of separate manufacture, use, or sale as claimed, and are patentable over each other.

A process and an apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process. MPEP §806.05(e) (Emphasis in original). The Examiner has failed to show either that the process *as claimed* can be practiced by another materially different apparatus or by hand, or that the apparatus *as claimed* can be used to practice another and materially different process. The Examiner simply concludes that the process of claims 19-22 can be practiced by another materially different apparatus or by hand. Indeed, it is obvious that because a percussive tool must be used to remove

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the component from its seat in claims 19-22, the component must be sufficiently tightly seated that it cannot be removed by hand. Furthermore, the Examiner has offered no example of another apparatus that can practice the process of claims 19-22. Finally, the process of claims 19-22 requires a reciprocating air hammer. Thus, the process "as claimed" can only be practiced by the use of the hammer claimed in claims 19-22. The process of claims 19-22 "as claimed" cannot therefore be practiced by another materially different apparatus or by hand.

The Examiner identifies invention I as classified in class 83, and invention II as classified in class 29, subclass 426.1. Class 83 relates to methods and machines for cutting or penetrating material. Class 29, subclass 426.1 relates to disconnecting disassociating, disintegrating, or otherwise removing one or more parts in a final relationship of parts. These two classes are relevant to all claims in the application, and thus should be searched for all claims. The burden on the Examiner will not be increased by having to conduct a search related to both alleged inventions.

Applicant confirms a provisional election with traverse of alleged invention I (claims 1-18, 23-36).

CONCLUSION

However, to comply with the requirements set forth by the Examiner, for these reasons, the Applicant asserts that the restriction requirement should be withdrawn. If there are any outstanding issues which the Examiner feels may be resolved by way of telephone conference, the Examiner is cordially invited to contact the undersigned to resolve these issues. Early notification of allowability is respectfully requested.

Respectfully submitted,

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